

### **REMARKS**

In the Office Action, claims 21-32, 53-64, 67, 71, and 72 were rejected and claims 1-20, 33-52, 65-66, and 68-70 were withdrawn from consideration. In the Office Action Summary, the Examiner noted that claim 67 was rejected. However, the Examiner failed to indicate on what basis claim 67 was rejected, thereby preventing the Applicants from providing a meaningful response or amendment to the omitted rejection. Further clarification regarding the status of claim 67 is, therefore, respectfully requested.

By the present Response, Applicants amend claims 1, 33, 65, and 68. Upon entry of the amendments, claims 1-72 will remain pending in the present patent application. Applicants respectfully request reconsideration of the pending claims in view of the foregoing amendments and the following remarks.

### **Restriction Requirement**

The Examiner had previously restricted examination of claims 1-72 in this application. Specifically, the Examiner required election between what were alleged to be three patentably distinct species of the claimed invention. In particular, the Examiner identified:

- Species I represented by: acquiring electrical data representative of cardiac motion and non-electrical data representative of cardiac motion (claims 1-9, 33-41, 65, and 68);
- Species II represented by: acquiring non-electrical data representative of cardiac motion and data representative of respiratory motion (claims 10-20, 42-52, 66, and 69-70); and
- Species III represented by: acquiring electrical data representative of cardiac motion, non-electrical data representative of cardiac motion; and data representative of respiratory motion (claims 21-32, 53-64, 67, and 71-72).

In accordance with 37 C.F.R. § 1.143, Applicants timely elected to prosecute Species III which was believed to include claims 21-32, 53-64, 67, and 71-72. This election was made with traverse.

On May 23, 2006, the Examiner discussed the basis for the Restriction requirement with the undersigned and explained the basis for his assertion that Species III was not generic with regard to Species I and II. Applicants respectfully thank the Examiner for his time and explanation. However, after consideration of the Examiner's comments, Applicants remain convinced that the present Restriction requirement is improper *regardless* of what genus:species or species:species relationships exist between the asserted groupings of claims.

In particular, the Applicants object to the Examiner's restriction requirement on the ground of a lack of "serious burden" on the Examiner. As set forth in the Manual of Patent Examining Procedure, there are two criteria for restriction: (1) the inventions must be independent or distinct as claimed, and (2) there must be a serious burden on the Examiner if restriction is not required. *See* M.P.E.P. (Eighth edition, revision. 4) § 803, Section I. Furthermore, the M.P.E.P. clearly states that, "[i]f the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions." M.P.E.P. § 803 (emphasis added).

As is clear from the description of the identified species set forth above, the search required for the Examiner to properly examine Species III encompasses the searches that would be required to examine Species I and II. Indeed, any examination of the claims of Species III would also appear to encompass the examination that would be performed for the claims of respective Species I and II. For at least these reasons, the Applicants believe that the present restriction is not proper as no "serious burden" would be placed on the Examiner in requiring examination of Species I and II in conjunction

with the examination of Species III. Absent such a “serious burden,” the Applicants stress that restriction is improper. Therefore, Applicants respectfully request claims 1-20, 33-52, 65-66, and 68-70 be reinstated.

### **Rejections Under 35 U.S.C. § 102**

In the Office Action, the Examiner rejected claims 21-22, 24-32, 53-54, 56-64, and 71-72 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,701,897 (hereinafter “the Sano reference”). Applicants respectfully traverse this rejection.

### ***Legal Precedent***

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Moreover, the prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Accordingly, Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter.

### ***Omitted Features of Independent Claims 21, 53, and 71***

Turning now to the present claims, the Sano reference fails to disclose each element of independent claims 21, 53, and 71. Specifically, independent claims 21, 53, and 71 each generally comprise the acquisition of “one or more sets of motion data representative of respiratory motion.” Additionally, independent claims 21, 53, and 71 each generally comprise the generation of a set of multi-input motion data comprising the “one or more sets of motion data representative of respiratory motion.” The Examiner has not pointed out, nor have the Applicants independently identified, any portion of the

Sano reference which specifically discloses elements relating to “one or more sets of motion data representative of respiratory motion.” Indeed the passage cited by the Examiner in regard to this recitation is entirely silent as to respiration and/or respiratory motion. Therefore, the cited Sano reference fails to anticipate independent claims 21, 53, and 71. Accordingly, Applicants respectfully request withdrawal of the present rejection and allowance of independent claims 21, 53, and 71 and those claims respectively depending therefrom. Furthermore, if the Examiner chooses to maintain the present rejection, the Applicants respectfully request that the Examiner provide a specific citation to the Sano reference disclosing the subject matter discussed above, as required by 37 C.F.R. § 1.104(c)(2).

#### **Rejections Under 35 U.S.C. § 103**

In the Office Action, the Examiner rejected claims 23 and 55 under 35 U.S.C. § 103(a) as being unpatentable over the Sano reference. Applicants respectfully traverse this rejection.

#### ***Legal Precedent and Examination Guidelines***

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by modifying the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the modification. MPEP § 2142. Accordingly, to establish a *prima facie* case, the Examiner must not only show that the prior art reference includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the prior art. *Id*; see also *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

***Deficiencies of the Rejections***

Applicants note that claims 23 and 55 depend on independent claims 21 and 53, respectively. As discussed above, the Sano reference fails to disclose each element of independent claims 21 and 53. As a result, dependent claims 23 and 55 are allowable on the basis of their dependency from a respective allowable independent claim, as well as for the subject matter separately recited in these dependent claims.

Furthermore, Applicants contend that claims 23 and 55 are not obvious to one having ordinary skill in the art. The Examiner's contention in rejecting claims 23 and 55 rests on the notion that it would have been obvious to one having ordinary skill in the art to modify the system as taught by Sano to apply to different types of organs. This, however, is not the subject matter recited in independent claims 23 and 55. Instead, claims 23 and 55 recite the acquisition of "one or more sets of motion data for one or more *proximate* organs." (Emphasis added). The referenced passage from the Sano reference, however, appears to merely indicate that the disclosed system can image tissues and organs other than cardiac tissue. Such a teaching merely indicates that organs other than the heart can be imaged but does not suggest, teach, or imply that motion data for one or more proximate organs is acquired or used in any manner. Accordingly, Applicants respectfully request withdrawal of the present rejection and allowance of claims 23 and 55.

**General Authorization for Extensions of Time**

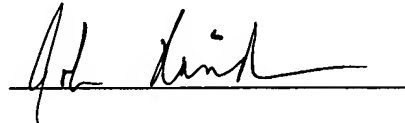
In accordance with 37 C.F.R. § 1.136, Applicants hereby provide a general authorization to treat this and any future reply requiring an extension of time as incorporating a request therefore. Furthermore, Applicants authorize the Commissioner to charge the appropriate fee for any extension of time, or for any other fees currently due, to Deposit Account No. 06-1315; Order No. 132958-1/YOD (GEMS:0236).

**Conclusion**

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: May 24, 2006

A handwritten signature in black ink, appearing to read "John M. Rariden", is written over a horizontal line.

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